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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/674,853	11/07/2000	Fulvio Mavilio	1303-110	5693

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EXAMINER

WEHBE, ANNE MARIE SABRINA

ART UNIT PAPER NUMBER

1632

DATE MAILED: 01/31/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/674,853

Applicant(s)

Mavilio

Examiner

Anne Marie Wehbé

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Dec 26, 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached sheet.

3. ☐ Applicant's reply has overcome the following rejection(s):

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:

The newly proposed claims have not been entered. Applicants have not provided any new arguments and thus the ground of rejection in paper no. 6 stand.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-10

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

10. ☐ Other:

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Attachment to Advisory Action

2. Applicant's proposed amendment cancels pending claims 1-10 and requests entry of new claims 11-18. The new claims are not directed to the same subject matter as the previous claims and as such would require additional search and/or consideration. In particular, the applicant's new methods are directed to increasing the frequency of myogenic conversion of genetically engineered dermal fibroblasts while the pending claims are directed to methods of genetically modifying fibroblasts. As such the new claims would require further consideration for compliance with 35 U.S.C. 112, first paragraph, for enablement, and would require further search regarding new limitations such as "increasing frequency of myogenic conversion", and "rate of myogenic conversion is greater than 40%".

In regards to applicant's statement that the examiner has already considered and discussed the subject matter of the new claims in the final office action, the applicant has provided an inaccurate and misleading interpretation of the examiner's statements in paper no. 6. Applicant's previous arguments provided in the amendment received on 7/1/02, paper no. 5, made several statements regarding how the references cited by the Office under 35 U.S.C. 103 failed to demonstrate increased frequency of myogenic conversion, or demonstrate rates of myogenic conversion greater than 40%. In response to this amendment, the examiner on pages 3-6 of the final office action, paper no.6, **referenced** applicant's arguments and provided detailed reasons why these arguments were **not** sufficient to overcome the rejection of the pending claims under 35

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U.S.C. 103 . The examiner's statements regarding increased frequency of myogenic conversion and rates of myogenic conversion greater than 40% in paper no.6 are limited to an indication that the pending claims of record did not recite these limitations. The examiner made no suggestion whatsoever that the applicant amend their claims. Further, the examiner never suggested or implied that the subject matter of proposed claims 11-18 would be allowable or would not require further consideration under 35 U.S.C. 112, 102, or 103.

Any inquiry concerning this communication from the examiner should be directed to Anne Marie S. Wehbé, Ph.D., whose telephone number is (703) 306-9156. The examiner can be reached Mon-Fri from 10:30-7:00 EST. If the examiner is not available, the examiner's supervisor, Deborah Reynolds, can be reached at (703) 305-4051. General inquiries should be directed to the group receptionist whose phone number is (703) 308-0196. The technology center fax number is (703) 308-4242, the examiner's direct fax number is (703) 746-7024.

Dr. A.M.S. Wehbé

ANNE M. WEHBE' PH.D
PRIMARY EXAMINER

